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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,781	09/27/2000	Paul C. Daly	00-39 RCE 1	6751
30031	7590	01/09/2009		
MICHAEL W. HAAS RESPIRONICS, INC. 1010 MURRY RIDGE LANE MURRYSVILLE, PA 15668			EXAMINER WEINSTEIN, STEVEN L.	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			01/09/2009 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PAUL C. DALY

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Application 09/670,781  
Technology Center 1700

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Mailed: January 8, 2009

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Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on June 30, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

### **APPEAL BRIEF, ARGUMENTS**

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed November 13, 2006 under the heading “Argument” have not been clearly provided. Each grounds of rejection must be treated under a **separate heading** in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

Appellant has not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8<sup>th</sup> ed. Rev. 5, August 2006) for details.

### **EXAMINER’S ANSWER, GROUNDS OF REJECTION**

A review of the file indicates that the Examiner’s Answer filed March 1, 2007 does not comply with the guidelines provided in MPEP § 1207.02 because it refers, either directly or indirectly, to a prior Office action without fully restating the point relied upon in the answer. See the § 103(a) rejection of claims 12, 13, 15, 16, 22, 17, 19, 20 and 37-39 located on page 8. If there is a complete and thorough development of the issues in a prior action, the

examiner may copy any referenced prior rejection(s) from the prior Office action into the Examiner's Answer. The examiner is reminded to reevaluate his or her prior position in light of the arguments presented in the Brief, and should expressly withdraw any rejections not adhered to in the "Grounds of Rejection Withdrawn" section of the Examiner's Answer.

Therefore, a substitute Examiner's Answer which fully restates any prior points relied upon in the Answer, is required. *See* MPEP § 1207.02 for details.

### **CONCLUSION**

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on November 13, 2006 defective;
- 2) to notify Appellant to file a paper properly presenting the arguments for each grounds of rejection as required;
- 3) for consideration of said paper;
- 4) to vacate the Examiner's Answer mailed March 1, 2007;
- 5) to generate a new Examiner's Answer which does not refer directly or indirectly to a prior Office action without fully restating the point(s) relied on in the Answer; and

6) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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